

### **REMARKS**

This responds to the Office Action dated August 23, 2005, and the references cited therewith.

Claims 1, 8, 9, 11, 13, 19, 25 and 26 are amended, claims 16-18 are canceled, and no claims are added; as a result, claims 1-15 and 19-26 are now pending in this application.

#### **§102 Rejection of the Claims**

Claims 1-15 and 19-23 were rejected under 35 U.S.C. § 102(e) for anticipation by Hess et al. (U.S. 6,415,320).

Anticipation requires the disclosure in a single prior art reference of each element of the claim under consideration. *In re Dillon* 919 F.2d 688, 16 USPQ 2d 1897, 1908 (Fed. Cir. 1990) (en banc), cert. denied, 500 U.S. 904 (1991). It is not enough, however, that the prior art reference discloses all the claimed elements in isolation. Rather, “[a]nticipation requires the presence in a single prior reference disclosure of each and every element of the claimed invention, *arranged as in the claim.*” *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 221 USPQ 481, 485 (Fed. Cir. 1984) (citing *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 220 USPQ 193 (Fed. Cir. 1983)) (emphasis added).

Applicants respectfully submit that the Office Action did not make out a *prima facie* case of anticipation for the following reasons.

#### **Claim 19: Hess does not teach each and every claim element**

Claim 19 recites:

*A computer system comprising:*

*a processing unit;*

*a memory coupled to the processing unit through a system bus;*

*a computer-readable medium coupled to the processing unit through the system bus, and*

*an instruction embedded in a markup language document in the memory to cause the processing unit to execute a utility program*

*from the computer-readable medium, wherein the utility program causes the processing unit to determine a number of images to display in the markup language document, select the number of images from a group of images, and place the selected images in the markup language document.*

(Emphasis Added)

The Office Action contends that Hess teaches a system comprising the same elements as in claim 19. Specifically, with reference to the above emphasized limitations of claim 19, the Office Action points to the abstract and column 3, lines 17-26 of Hess. Applicants strongly disagree that the identified sections of Hess disclose a utility program that is capable of causing a processing unit to determine a number of images to display and to select the number of images from a group of images. Neither does Hess disclose “an instruction embedded in a markup language document.”

First, Hess provides that:

In the Web environment, Web browsers reside on clients and render Web documents (pages) served by the Web servers.

(Hess, Col. 4, ll. 9-11) (Emphasis Added)

Thus, the Web browser in Hess resides on clients and renders Web documents served by Web servers. The Web browser does not constitute “a utility program,” as required by claim 19, because it lacks the ability to cause the processing unit to determine a number of images.

Furthermore, the disclosures in Hess are limited to retrieving or harvesting images based upon “user-supplied information.” Hess, in pertinent part, provides the following:

According to one aspect of the present invention, person-to-person commerce over the Internet is facilitated by providing prospective buyers the ability to quickly preview items for sale. Images are harvested from a plurality of sites based upon user-supplied information. The user-supplied information includes descriptions of items for sale and locations from which images that are to be associated with the items can be retrieved. Thumbnail images are created corresponding to the harvested images and are aggregated onto a web page for presentation at a remote site.

(Hess, Abstract, Page 1) (Emphasis Added)

Advantageously, according to one aspect of the present invention, to associate an image with an item for sale, the seller is not required to provide the image in a particular format or size; rather, the method and apparatus of the present invention automatically harvest images and transform them to an appropriate format for use with the system. According to another aspect of the present invention, prospective purchasers visiting an online commerce site employing the present invention need not navigate to a separate web page for each item to view images associated with the items; rather, thumbnail images for multiple items are aggregated onto a web page to allow quick preview by the prospective purchaser. (Hess, Col. 3, ll. 14-26)

Accordingly, Hess, while providing some disclosure regarding specific user-supplied information regarding the locations of images, does not disclose a utility program (e.g., the gallery widget discussed as an example embodiment in the present application) that causes a processing unit to select a number of images from a group of images.

Finally, Hess does not disclose an instruction embedded in a markup language document. Hess, when referring to Web documents, provides that:

When a user selects a document by submitting its Uniform Resource Locator (URL), a Web browser, such as Netscape Navigator or Internet Explorer, opens a connection to a server **210** and initiates a request (e.g., an HTTP get) for the document. The server **210** delivers the requested document, typically in the form of a text document coded in a standard markup language such as HyperText Markup Language (HTML).

(Hess, Col. 4, ll. 15-22) (Emphasis Added)

Clearly, there is no disclosure of an instruction embedded in a markup language document in Hess. The disclosures in Hess are limited to a selection of a document by submission of a Uniform Resource Locator (URL) (e.g., via an HTTP get).

In summary, Hess does not disclose each and every element of claim 19 because (1) the Web browser of Hess is not a utility program, as required by claim 19, since it does not cause the processing unit to determine a number of images; (2) in Hess, images are harvested based on

user-supplied information of image locations rather than selected by a utility program from a group of images; and (3) Hess fails to teach an instruction embedded in a markup language document that causes a processing unit to execute a utility program that performs the functions recited in claim 19.

**Claims 13 and 26: Hess does not teach each and every claim element**

With respect to the rejection of independent claims 13 and 26, certain of the arguments presented herein with reference to claim 19 apply. In addition, the Office Action alleges:

Hess further teaches:

- (i) obtaining a set of random numbers corresponding to the number of images (*thumbnail images are accessed from the thumb server by item number ... references to the thumbnail images; col. 9, lines 12-23*); and
- (ii) receiving images from a group of images using the set of random numbers (*in response to a user query; such as a request for a particular page within a particular category; a list of items is displayed; col. 9, lines 42-59*).

(Office Action, Page 5)

Claim 13 recites:

*A computer-readable medium having stored thereon executable instructions for causing a computer to perform a utility program for selecting images for a markup language document comprising:*

*determining a number of images to display in the markup language document;*  
*obtaining a set of random numbers corresponding to the number of images;*  
*retrieving images from a group of images using the set of random numbers; and*  
*placing the retrieved images in the markup language document.*

(Emphasis Added)

However, Hess only provides that:

At step 830, the predefined page format is populated based upon the information retrieved in step 820. At this point, it should be noted that according to one embodiment of the present invention, thumbnail images are accessed from the thumb server 430 by item number. As one feature of this embodiment, references to the thumbnail images stored on the thumb server 430 may be generated on the fly by the listing management process 415 based upon the image format and the item number. For example, an inline image tag can be generated having the

general form: <img src=path/item\_number.jpg>. In this manner, no additional space is required in the listing database for image file names.

(Hess, Col. 9, ll. 12-23) (Emphasis Added)

FIG. 9 is an example of an item presentation format for an online person-to-person trading site according to one embodiment of the present invention. The Gallery presentation page format 900 of the present embodiment includes a text mode button 975 and a photo mode button 980 allowing the user to switch between the text-based item listing format and the Gallery presentation format. In response to a user query, such as a request for a particular page 970 within a particular category 960, a list of items 905 is displayed to the users. In this example, each individual item 910 includes a thumbnail image 920, a title 915, a current minimum bid 930, and the auction ending time 950. Advantageously, in this manner, the Gallery presentation page format 900 allows a prospective buyer to quickly scan the thumbnails for items of interest. Such a feature becomes critical in an online commerce environment in which thousands of unique items are for sale, for example.

(Hess, Col. 9, ll. 42-59)

Therefore, Hess only discloses thumbnail images accessed from the thumb server or generated by the listing management process based on item numbers. Clearly, there is no disclosure in Hess of obtaining a set of random numbers, corresponding to a number of images, and then retrieving images utilizing the set of random numbers. As a result, Hess fails to disclose at least the above identified limitation of claim 13.

Claim 26 includes elements (or limitations) sharing terminology substantially corresponding to the above described terminology of claim 13, and Applicants contend that claim 26 is not anticipated by Hess for the same reasons provided above.

### **Claims 1 and 25: Hess does not teach each and every claim element**

With respect to the rejection of independent claims 1 and 25, certain of the arguments presented herein with reference to claim 19 apply. In addition, the Office Action alleges:

Hess further teaches:

- (i) dynamically selects an image (*automatically harvest images; col. 3, lines 17-19 and col. 7, lines 6-9*); and
- (ii) selecting, by the utility program, a pre-determined number of images from a group of images, the pre-determined number being specified in the instruction

*(Image are harvested from a plurality of sites based upon user-supplied information ... base upon a user-specified image; see the Abstract).  
(Office Action, Page 5)*

Claim 1 recites:

*A computerized method for selecting images for a markup language document comprising:*  
*encoding an instruction in the markup language document, the instruction identifying a utility program that selects an image for insertion into the document;*  
*preparing the markup language document for display;*  
*invoking the utility program when the instruction is processed;*  
*selecting, by the utility program, a pre-determined number of images from a group of images, the pre-determined number being specified in the instruction; and*  
*placing, by the utility program, the pre-determined number of images in the markup language document at locations defined in the instruction.*

(Emphasis Added)

By contrast, Hess provides:

Advantageously, according to one aspect of the present invention, to associate an image with an item for sale, the seller is not required to provide the image in a particular format or size; rather, the method and apparatus of the present invention automatically harvest images and transform them to an appropriate format for use with the system.

(Hess, Col. 3, ll. 14-19) (Emphasis Added)

[T]he harvesting process **455** automatically downloads the specified image, converts it to the appropriate format and scales it to the appropriate size that is appropriate for use with the Gallery presentation mechanism.

(Hess, Col. 7, ll. 6-9) (Emphasis Added)

As a result, although Hess mentions a harvesting process that automatically downloads, converts, and scales user-specified images, Hess does not disclose a utility program that selects a pre-determined number of images. Hence, Applicants strongly argue that Hess fails to disclose at least the above identified element of claim 1, and the Office Action thereby does not make a *prima facie* case of anticipation with respect to claim 1.

Claim 25 includes limitations with terminology substantially corresponding to the above described terminology of claim 1, and Applicants contend that claim 25 is not anticipated by

Hess for the same reasons provided above.

**Dependent claims: Hess does not teach each and every claim element**

With respect to the claims that depend on independent claims 1, 13 and 19, a dependent claim is deemed to include the limitations of an independent claim from which it depends. Therefore, the above arguments for independent claims 1, 13 and 19 are also applicable in addressing the rejection of the dependent claims under 35 U.S.C. § 102(e).

Accordingly, the rejection of claims 1-15 and 19-26 under 35 U.S.C. § 102(e) has been addressed, and the withdrawal of this rejection is respectfully requested.

**CONCLUSION**

Applicants respectfully submit that the claims are in condition for allowance, and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicants' attorney at 408-278-4042 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: Mail Stop Amendment, Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 23 day of February, 2006.

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